

## 35 USC 103 Claim Rejections Overcome

4. Applicant wishes to submit the following, which, as will be appreciated, forms a thorough and well-reasoned basis for overcoming the Second OA's obviousness rejections by strongly, clearly, convincingly, and unequivocally demonstrating the novelty and nonobviousness of the present invention:

### The References and Differences of the Present Invention Thereover

5. Prior to discussing the claims, applicant will first discuss the invention, the references, and the general novelty of the present invention and its unobviousness over the references.

6. Applicant's ground-breaking invention teaches how to *anonymously* match an up to unlimited number of (including little-known and hard-to-find) government and non-government benefits and benefit information within and throughout all benefit classes/categories *directly* to entities of all types—individuals as well as companies/businesses, educational institutions, governments, etc; doing so with *no required advance knowledge or understanding* of these benefits by the benefit-seeking entity; using *only* the demographic, geographic, psychographic, and preference information of the entity itself to identify and locate the benefits (being offered by the now *far more efficient and effective* benefit providers themselves). Making the present invention a novel and unobvious method and system the likes of which has never been known before.

7. College Board ([www.collegeboard.com](http://www.collegeboard.com), Screen Print, 1/25/1999) makes clear that their system/method is for the express and limited single purpose of matching individuals only with “ . . . scholarships, loans, internships, and other financial aid programs from non-college sources . . . ” (from page 2 of the 1/25/1999 screen print reference). Note also the even further negatively recited limitation of the College Board’s educational class/category of benefits as being required to be only from “ . . . non-college sources . . . ” (screen print, p.2). In fact, the next sentence goes on to clarify what their system/method *really is* and what individuals *actually received* when they used their

system/method, namely (and only) “ . . . potential scholarship opportunities . . . ” Note also in the following paragraph that College Board’s system/method is called (appropriate given its stated purpose) “*Scholarship Search*;” and that Scholarship Search’s information is derived from “*The Scholarship Search Handbook*. ” Demonstrating that College Board/Scholarship Search is a *limited* benefit-matching system.

Applicant’s method/system (as is clear from its specification), on the other hand, is novel and different from College Board by having no such limits in either the classes/categories or the types of benefits which may optionally be made available; and does so just for individuals, but *entities of all types*—including businesses, non-profits, educational institutions, and cities & states. One has only to visit the GovBenefits.com and BenefitsCheckUp.org (BCU) sites to fully appreciate the functional differences between them/the present invention and College Board/Scholarship Search.

As would be clear given both its stated purpose and actual operation; College Board does not teach any more than how to match *educational* class/category *non-college* aid with *individuals* seeking such *educational* class/category aid. Unfortunately (and though applicant wishes it did exist), neither College Board nor any other company, individual, or organization apparently had the foresight to patent such a scholarship-matching business method; limited in its use and value relative to the present invention though it would be. Such a limited patent would—were it in existence—clearly, convincingly, and obviously not anticipate nor make obvious the present invention [See also applicant’s 9/23/2003 Amendment for an expanded treatment.]

8. **Baker, III** (US 6,266,648) is—by its own description--a method/system of aggregating “third-party enabling organizations” (credit card companies, professional associations, etc) in order to simplify the identification of (primarily) travel/vacation related benefits offered only by/through these enabling organizations; such benefits being available only to people having affiliations/memberships with these enabling organizations.

There are three critically important differences of the present invention over Baker:

9. First, because such information is neither gathered nor correlated directly to the benefits themselves, Baker is unable to identify any benefits which the system user would qualify for based on user's demographic, geographic, or psychographic information; Baker requiring only that the user input user identification information to verify enabling organization association plus user's purchase plan/interest(s)/preference data (abstract; C3 L2-3, L23-24, L29, L33-35; C4 L16-19; C5 L10-13; C7 L36-45, L50-55). Yet, this is one of the prime purposes (and huge advantages) of the present invention—that is, to enable people/entities to—*quickly, easily, and automatically*—discover the up to 100's to 1,000's of *often unknown* benefits they (may) already qualify for without having to know what they're looking for. [See also # 99, page 20 of first OA, “*Baker discloses a computer system that can correlate benefits between consumers and one or more enabling organizations . . .*” (and therefore not directly between consumers/entities and the benefits themselves)]. With Baker, you have to know what you want in order to get it. With the present invention, you never do. Which is a wonderful difference indeed.

10. Second, Baker requires an association with one or more benefit “providing” enabling organizations in order to receive any benefits; and then, you can receive only those benefits available from such enabling organizations (abstract, C1 L16-19; C3 L17-19, L25-27, L44-45 and elsewhere). *Not so with the present invention*. With Baker, one must be a “member” to get—only—“member” benefits. With the present invention, you don’t have to be a “member” of anything to get your benefits . . . and you don’t have to settle for just those benefits offered by enabling organization<sup>6</sup> either.

11. Third, because it’s understandably needed to verify “affiliation” with the enabling organization(s), Baker requires some type of user identification in order to use the system (abstract, C2 L51-53; C3 L22-23, C6 L4-8, and elsewhere). The problem is that the users anonymity is then sacrificed; every time they attempt to see if the benefits they want are available to them—whether or not they even exercise their right to use them. Such loss of privacy is a major, growing problem in today’s society. With Baker, they know who you are (your name), what you want, when you want it, and how much you’re willing to pay

for it. With the present invention (optimally/optionally), because you get the benefit information/benefits confidentially--they know nothing.

Thus the present invention has great and substantial differences over Baker. The clearly novel and unobvious present invention is of far greater use, utility, and value (certainly by at least a factor of 5-10) than Baker. Applicant's invention is a benefit-matching method and system clearly unlike any that came before.

### **College Board and Baker Do Not Contain Any Justification to Support Their Combination, Much Less in the Manner Proposed**

12. The prior-art references do not contain any suggestion--express or implied--that they be combined, or that they be combined in the manner suggested. With regard to the proposed combination of College Board and Baker, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined, e.g., as was stated In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

13. That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (CAFC 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO].”

14. As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988):

“[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself . . . *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*” [Emphasis supplied.]

15. In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A. & I. 1993):

"In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. . . . That which is within the capabilities of one skilled in the art is not synonymous with obviousness. . . . That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. . . . Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' . . . Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

[Emphasis supplied.]

16. In the present case, there is no reason given in the last OA to support the proposed combination, other than the nearly identical statements, "Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included . . . *means for inputting into said system benefit information from two or more distinctly different benefit classes/categories*" (Page 4, # 10); ". . . *wherein the benefits are from at least two distinctly different benefit classes/categories . . .*" (Page 12, # 58; Page 13, # 62; Page 16, # 79 ); ". . . *wherein the benefits contain at least two distinctly different benefit classes/categories . . .*" (Page 15, # 70). However, the fact that both references teach some aspects of "benefit matching" is not sufficient to gratuitously and selectively substitute one or more parts of one reference (Baker's multiple benefit classes/categories) for one or more parts of another reference in an attempt to meet applicant's novel claimed invention. Additional caselaw has also made clear that reconstruction of the invention from the prior art with the benefit of applicant's own disclosure is improper.

17. The 2<sup>nd</sup> OA noted (pages 4, 12, 13, 15, and 16) that the combination of College Board and Baker produces advantages (increased system effectiveness and customer service). Applicant submits that the fact that the combination (were it legally justified and proper) produces advantages militates in favor of *applicant* because it proves that the combination as envisioned by the examiner produces new and unexpected results and hence is unobvious.

18. As stated in the above Levengood case,

“That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.”

### **Individually-Complete References Proves that the Combination of the References is Not Justified**

19. Each reference is complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to either reference. College Board has been a complete, functioning/operating service for some years now; and while there appears to be no known “real world” application of/utilizing Baker; as its detailed specification including its drawings demonstrate, it, like College Board, is also complete and functional in and by itself. There are, therefore, no reasons to use parts from, or add or substitute parts to, either reference. That they are each individually complete demonstrates and proves that the combination of the references is not justified.

### **Different-Field References Proves that the Combination of the References is Not Justified**

20. The references are from very different technical fields from each other. Despite the widespread use of the term “benefit(s)” during the prosecution of this application, a close inspection revels that the two references themselves are in fact from very different and unrelated technical fields. Specifically, College Board is—by its own description and actual operation—a limited-purpose method/system for the identification only of non-

college scholarships/educational financial aid. Baker, on the other hand, is—by its own description/specification--a method/system of aggregating enabling organizations in order to simplify the identification of primarily travel/vacation related benefits offered only by/through these enabling organizations; and only to people having affiliations with these enabling organizations. Therefore, because locating non-college educational financial aid for consumers (College Board) and aggregating enabling “membership” organizations (Baker) are most certainly unrelated to each other—and therefore *nonanalogous art*—there is no justification for the combination of these references.

### **The Proposed Modification Cannot Render the Prior Art Unsatisfactory for Its Intended Purpose—MPEP 2143.01**

*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.* In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

21. Specifically, as stated, College Board is negatively and self-limited (negatively recited) only to the identification of and locating of *non-college* educational financial aid (for individuals) (p.2 of screen reference). Combining then Baker’s *variety* of benefits (if it were legal and proper to do so) with College Board would, because up to all benefits (in up to all classes/categories for individuals) would now be available (for individuals), actually *cripple the purpose for which the College Board service exists*. That is, such a combination system would no longer be able to *match individuals exclusively and solely with non-college educational financial aid*; as College Board says it must. Thus, while the benefits identified and matched could certainly still be included in a total “benefits found disclosure/display,” because the proposed modification would render the prior art (College Board) unsatisfactory for its intended purpose, under MPEP 2143.01, the combination of College Board with Baker is neither legal nor proper.

## The Proposed Modification Cannot Change the Principle of Operation of a Reference –MPEP 2143.01

*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).*

22. Specifically, as stated, College Board is negatively and self-limited (negatively recited) only to the identification of and locating of *non-college* educational financial aid (for individuals) (p.2 of screen reference). Combining then Baker's *variety* of benefits (if it were legal and proper to do so) with College Board would, because up to all benefits (in up to all classes/categories for individuals) would now be available (for individuals), actually *change the manner in which the College Board service operates*. That is, College Board's constricted and limited system could no longer operate by simply drawing its non-college educational aid information from its *Scholarship Handbook* book database; but would instead now have to, as stated, develop, create, and implement an entirely new *unlimited* methodology and system capable of delivering an up to virtually unlimited number and benefit class/category variety of benefits. Thus, because its single-class system is clearly inadequate for such an endeavor; such a logically challenging modification must by obvious inherent necessity *change the principle of operation of the prior art* (College Board) in order to work. Therefore, under MPEP 2143.01, the combination of College Board with Baker is neither legal nor proper.

There is no *prima facie* justification for combining the references as suggested; as required by MPEP 2142 and 2143.

Applicant therefore submits that combining College Board and Baker is not legally justified and is therefore improper. Thus, applicant submits that the rejection on these references is also improper and should be withdrawn.

Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P.

706.02, Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levengood, supra, a “factual basis (or *prima facie* case) to support examiner’s conclusion that it would have been obvious” to make such a combination.

23. **Misunderstood References.** The Baker and College Board references do not disclose what the examiner relies upon them as supposedly teaching:

Baker: The last OA states (page 4, # 9; p.12 # 57; p.13 # 61; p.15 # 69; p.16 # 78) that, “Baker discloses a method/system for permitting a consumer to more effectively make use of a variety of available benefits from a plurality of goods and service providers (abstract, C3 L5-51).” However, Baker’s abstract states “ . . . wherein the benefits are offered specifically to those consumers having an association with one or more enabling organizations.” and, “ . . . enabling organization information . . . “ etc.; plus C1 L16-19 (note “ . . . only to those having . . . “ ); and in C3 L5-51 (in particular L17-19, “ . . . offered specifically to those consumers having an association with one or more enabling organizations.” , L25-26, “ . . . enabling organization information . . . “ , L27, “ . . . enabling organization . . . “ L44-45, “ . . . consumer’s membership in [the] one or more enabling organizations.” ) [see also # 5, pages 3 & 4, above; as well as # 99, page 20 of the first OA]. As is stated and made clear throughout Baker—in its title, its abstract, background, summary; throughout its specification, claims, and even in its drawings—these enabling organizations are not merely of a subsidiary nature but are in fact an integral part and critical, foundational element of the Baker invention.

24. Accordingly, [and in light again of # 5, p. 3 & 4, above] what Baker more accurately discloses is this: A method/system for permitting a *verified identified consumer who is affiliated with one or more third-party enabling organizations* to more effectively make use of a variety of *consumer identified and selected, enabling organization sourced* benefits from a plurality of goods and service providers. [Emphasis supplied.]

Paper Patent: Note here also that because the Baker reference appears to be a “paper patent;” that is, it was never implemented or commercialized, it should by necessity therefore be construed narrowly.

25. College Board: The last OA states that applicant's independent claims # 1 and 87 are what College Board discloses (p.3, # 7). However, [as seen on pages 3-4, #7, above) this reference makes clear that its system/method is for the express and limited single purpose of matching *individuals only* with " . . . scholarships, loans, internships, and other financial aid programs from non-college sources . . ." (from page 2 of the 1/25/1999 screen print reference). Note also the even further negatively recited limitation of the College Board's educational class/category of benefits as being required to be only from " . . . non-college sources . . ." (screen print, p.2). In fact, the next sentence of reference goes on to clarify what their system/method *really is* and what individuals *actually received* when they used their system/method, namely (and only) " . . . potential scholarship opportunities . . ." Note also in the following paragraph that College Board's system/method is called—appropriate given its stated purpose—"Scholarship Search;" and that Scholarship Search's information is derived from "*The Scholarship Search Handbook*." Demonstrating that College Board/Scholarship Search is a *limited* benefit-matching system.

As would be clear given both its stated purpose and actual operation; were the College Board system/method to have been backed by a patent; such a patent would have taught no better than how to match *educational* class/category *non-college* financial aid with *individuals* seeking such *educational* class/category aid. [See also applicant's 9/23/2003 Amendment.]

26. Therefore, what College Board more accurately discloses (p.3 # 7 of last OA) is: A system/method for permitting an *individual* to more effectively make use of *non-college educational financial aid* (hereinafter "*financial aid*") from a plurality of *financial aid* providers, wherein said *financial aid* is offered specifically to those *individuals* qualified/eligible to receive said *financial aid*, said system comprising: means for storing in a memory in the system *an individual's* information, *financial aid* provider information, and *financial aid* correlation information; means for inputting into said system a set of *an individual's* demographic, geographic, psychographic, and preference data for said *individual*; means for comparing said *individual's* data set to determine those *financial aid* providers, if any, which have *financial aid* said *individual* is qualified to utilize; means for analyzing said

*financial aid provider information and said financial aid correlation information to determine whether any financial aid providers are offering potentially applicable financial aid for said data and whether said data satisfies requirements for obtaining said potentially applicable financial aid; means for displaying a message to inform a system user of any available financial aid applicable to said data; wherein said financial aid is available to the individual as a result of individual's qualifying or being eligible for at least one source of financial aid available from at least one financial aid provider.* [Emphasis supplied.]

27. Accordingly, what College Board discloses (p.12, # 55 of last OA) is: A system comprising a memory device having embodied therein information relating to *non-college educational financial aid* (hereinafter "financial aid"); a processor in communication with said memory device, said processor configured to: create a *financial aid* listing for a specified *individual* with a specified set of demographic, geographic, psychographic, and preference data; make available said *financial aid* listing; examine a plurality of *financial aid* that is available to a plurality of *individuals*, said listing to determine which of said plurality of *financial aid* having qualification parameters; select at least one of said *financial aid*; and provide notification of *financial aid* information to said *individual*, including the *financial aid* providers corresponding to said selected *financial aid*. [Emphasis supplied.]

28. Accordingly, what College Board discloses (p.13, # 59 of last OA) is: A system comprising a memory device having embodied therein information relating to a plurality of *non-college educational financial aid* (hereinafter "financial aid"); a processor in communication with said memory device, said processor configured to: receive a *financial aid* listing for a specified *individual* with a specified set of demographic, geographic, psychographic, and preference data; provide said *financial aid* listing to an *individual*; receive an acceptance of said *financial aid* listing from said *individual*; transmit said acceptance to a *financial aid* information provider; and receive *financial aid* information selected by said *financial aid* information provider, including the *financial aid* providers corresponding to said selected *financial aid*. [Emphasis supplied.]

29. Accordingly, what College Board discloses (p.14, # 67 of last OA) is: A method of using a computer to process a *non-college educational financial aid* (hereinafter "financial aid") information request, comprising the steps of: creating a *financial aid* listing; outputting said *financial aid* listing via an electronic system; examining a plurality of *financial aid* which would fulfill the *financial aid* information request relating to said *financial aid* listing to determine which, if any, of said plurality of *financial aid* to select for said *financial aid* listing; selecting, when available, at least one of said plurality of *financial aid*; outputting notification of *financial aid* information corresponding to said selected *financial aid*; and accepting at least one of said *financial aid*. [Emphasis supplied.]

30. Accordingly, what College Board discloses (p.16, #76 of last OA) is: A method comprising the steps of: viewing, using a computer, *non-college educational financial aid* (hereinafter "financial aid") information; transmitting, using a computer, a request to obtain at least one *financial aid* corresponding to said *financial aid* information; receiving a commitment for at least one *financial aid*; accepting said commitment for said at least one *financial aid*; and receiving said at least one *financial aid*. [Emphasis supplied.]

**Even if College Board and Baker Were to Be Combined in the Manner Proposed, the Proposed Combination Would Not Show All the Novel Features of the Present Invention**

31. However, even if the combination of College Board and Baker were legally justified; which applicant vehemently disputes; the claims of the present invention would still have novel and unobvious features over the proposed combination. In other words, applicant's invention, as defined by its independent claims, comprises much more than merely substituting Baker's multiple benefit classes/categories for a single class/category.

32. Specifically, note that both references teach clearly and unequivocally that theirs are *for-individuals-only* method/systems (College Board: screen print p.1-2; Baker: abstract; drawings Fig. 1, 2, 5a, 5b; C1 L15, L39, L51-52, etc.). The present invention, on the other hand, teaches all entities of all types (as readily seen, for example, in claims 1 and

87, ". . . storing in a memory in the system entity information," ". . . a set of entity demographic," ". . . comparing said entity information . . ." and, ". . . a plurality of entities," ". . . for said entity . . ." [claim 80] . . . and, ". . . for a specified entity . . ." [claims 81 and 82]); and as also readily detailed, presented, and taught throughout the present invention's abstract, its specification, drawings, etc.

33. With over 8,000,000 (8 million) businesses of all sizes in the US . . . over 35,000 American non-profits and charities . . . over 20,000 private and public educational institutions including colleges; high-, middle-, elementary-schools spread out across all 50 states . . . along with many 1,000's of cities, towns, counties, and other municipalities . . . this difference and the corresponding lack of "all-entities" enablement between the two references and the applicant's invention is no small matter. The ability to quickly and easily match the up to 1,000's of various and varied benefits designed for, targeted to, and available for each of these millions of *non-individual* entities is huge. Neither College Board nor Baker (and therefore no possible combination of the two) teaches *even a single sentence* to this novel, unobvious, and profoundly-valuable "benefit matching for all entities" capability. It is taught only by the present invention.

34. Additionally, as stated, College Board only matches individuals with non-college scholarships and Baker is only able to match individuals "affiliated" with third-party enabling organizations to benefits only offered by/made available from/through these third-party enabling organizations. Thus, an actual combination of the two references (were if legal and proper) would result in an odd method/system indeed. In fact, such a combined; awkward and constricted method/system would—due to each references' respective elements and the connections between such elements--do no better than enable the matching of third-party enabling organization affiliates with non-college educational financial aid sourced only through such third-party enabling organizations.

35. So now, instead of scholarship money being identified and made available to (potentially) virtually anyone via College Board, a combination with Baker would result in a privacy-compromising system whereby such scholarship funds would now only be

available to affiliates of enabling organizations. With College Board being actually and readily available for use by all for some years now, why would anyone even bother with such a nearly valueless combined method/system, were it to ever exist? There'd be no reason to. Demonstrating that College Board and Baker each provide *by themselves more utility and usefulness than any attempted combination of the two references would.*

36. Applicant's invention, on the other hand, is able to *anonymously* offer a plethora of virtually any and all government and non-government benefits/information within and throughout all benefit classes/categories *directly* to entities of all types—individuals as well as companies/businesses, educational institutions, governments, etc.

37. Given then its superiority [illustrated well in *Example/Dawn*; applicant's specification], applicant thus logically submits that the present invention clearly recites novel subject matter which distinguishes over any possible combination of College Board and Baker.

**The Novel Features of the Independent Claims Produce New and Unexpected Results and Hence are Unobvious and Patentable Over These References Under 35 USC 103**

38. Applicant also submits that the above quoted novel features of claims 1, 80, 81, 82, 87, 164, 169, and 176 are also unobvious and hence patentable under 103 since they produce new and unexpected results over College Board and Baker; or any combination thereof.

These new and unexpected results are the ability of the present invention to—for the first time in history—provide a practical and economically feasible system for quickly, easily, automatically, and anonymously matching a wide range of benefit-seeking entities with a wide range of diverse benefits (regardless of number of or type of benefit classes/categories) made available from up to virtually any number of benefit providers. The aggregation of so many varied benefits in one place at one time for the benefit of so many produces a compelling, synergistic, super-efficient “benefit-compounding” effect which produces disproportionate positive results for both the benefit-seeking entities and

the benefit providers. Because it is able to help far more people—*as well as millions and millions of other non-individual entities*—far more often in far more ways than limited, constricted systems like the references; the new, unexpected, disproportionate, unsuggested, and surprising results provided by the present invention are far and away superior to either College Board or Baker, or any possible combination thereof [illustrated well in *Example/Dawn*; applicant's specification]. The novel features of applicant's method/system which effect these differences are, as stated, clearly recited in independent claims 1, 80, 81, 82, 87, 164, 169, and 176.

### **Commercial Success Proves Nonobviousness Over the References**

39. Applicant has found two system/methods which infringe on applicant's invention and have quickly achieved dramatic nationwide success. As noted in applicant's previously approved Petition to Make Special, Benefits Check Up ([benefitscheckup.org](http://benefitscheckup.org)), launched in June of 2001 and run by the National Council On the Aging (NCOA); and GovBenefits ([govbenefits.gov](http://govbenefits.gov)), launched in April of 2002 and run by the United States Department of Labor, are both—according to both media reports and at their respective web sites ([ncoa.org](http://ncoa.org) in the case of BenefitsCheckUp)—already *each* receiving over 100,000 system users/visitors *each and every* month. Their quick, phenomenal successes powerfully demonstrates and proves the value of the novel and unobvious features of the present invention over College Board, Baker, or any combination thereof.

### **Solution of Long-Felt and Unsolved Need Proves Nonobviousness Over the References**

40. The present invention solves a long-felt but unsolved need. As explained and detailed in the present invention's specification, the need for a quick, easy, and accurate way to match benefit-seeking entities with the myriad of classes and types of benefits for which they qualify for has been a painful, unmet need for many, many years; stretching back in the U.S. even to the advent of government-provided social welfare programs in the 1930's. Applicant's invention now quickly, easily, and automatically solves this dilemma; something neither College Board, nor Baker, nor any combination of the two has or would ever be able to do.

### Synergism Proves Nonobviousness Over the References

41. The whole (that is—the results achieved by the present invention) is greater than the sum of its parts (that is—the respective results of the individual references). In comparing the results achieved by the two references, we see that College Board provides *just* individuals with *only* non-college educational financial aid; while Baker provides *just* individuals with *only* those benefits sourced through any third-party enabling organizations they happen to belong to. The present invention, on the other hand (as stated) anonymously provides up to a virtually *unlimited* number of benefits across *all* benefit classes to entities of *all* types—individuals and non-individuals alike. Even when taken in combination, the results achieved by College Board and Baker clearly and conspicuously in no way compare to the *volume of*, the *diversity of*, and *ease of accessibility to*; the results achieved by (as detailed throughout this Amendment) the present invention (even without the present invention's novel and valuable "benefits for non-individuals" teaching). This powerful synergistic effect proves the present invention to be nonobvious over College Board, Baker, or any combination of the two.

### Multiplicity of Steps Required Proves Nonobviousness Over the References

42. The combination suggested requires a series of separate, awkward combinative steps that are too involved to be considered obvious. College Board teaches only the matching of individuals with 3400 non-college educational financial aid source programs; said programs taken only from *The Scholarship Handbook*'s "programs database" (p.2 of reference). In order to integrate and combine Baker's multiple benefit classes/categories (were it legal and proper to do so) with College Board would require at a bare minimum: #1—The identification and categorization of up to 10's of 1,000's (or more) of varied benefits across both numerous and different benefit classes being offered by a myriad of benefit providers and provider-types located virtually everywhere in America; #2—The integration and correlation of these many 1,000's of benefits and benefit providers into the system; #3—The constant updating (and database management) of both the benefits themselves and their qualification, use, and availability parameters. Thus, given the series of separate, awkward combinative steps involved in attempting to create such a

combination, it's clear that neither College Board, nor Baker, nor any possible combination of the two could possibly render the present invention obvious. Yes, the present invention is a quicker, easier, and far better system than has ever existed before; but (as with the infringing GovBenefits and BenefitsCheckUp services), it requires a substantial amount of dedicated and continuous work and effort to make and keep it so. [And even then, as stated, because the resultant combination would (unlike the present invention) operate *only* for individuals, it would *still* fail to teach all that the present invention teaches.]

### **Competitive Recognition Proves Nonobviousness Over the References**

43. As noted above, the present invention has been (unknowingly) copied by at least two different infringers—The U.S. Department of Labor and the National Council on the Aging (NCOA). Moreover, James Firman, the President of NCOA, has made a number of statements to the media and via their website (ncoa.org) indicating that BenefitsCheckUp was the first web-based service ever to offer a wide range of benefits to those who are (or may be) qualified to receive them (in NCOA's case, "senior" citizens). Also, laudatory statements are being made on a regular basis to the media by many US federal government office holders and officials praising the wonderful and hugely-popular, Dept. of Labor-run GovBenefits service. Proving the present invention to be nonobviousness over College Board, Baker, or any combination of the two.

### **Assumed Insolubility Proves Nonobviousness Over the References**

44. Up to now those skilled in the art thought or found the problems solved by the invention to be insoluble. That is, the present invention converts the failure of others to come up with a quick, easy, and anonymous way to match benefit-seeking entities of *any* type *directly* with an up to unlimited number of—and *number of classes/categories of*—the benefits (and the benefit providers) themselves. These failures of prior-art workers indicates that a solution was not obvious. Proving the present invention to be nonobvious over College Board, Baker, or any combination of the two.

### New Principle of Operation Proves Nonobviousness Over the References

45. Instead of following a well-worn trail looking for incremental improvements in what already existed, the present invention utilizes a new "*anonymous, unlimited benefit class/category aggregation and dissemination*" principle of operation to blaze an exciting new trail; creating a far-more effective and useful benefit identification and matching system/method unlike anything that ever existed before. Clearly something neither College Board, nor Baker, nor any combination thereof could ever teach or deliver.

### Different Problem Solved Proves Nonobviousness Over the References

46. Applicant's invention solves a different problem than the references; and such different problem is recited in the patent/claims. *In re Wright*, 6 USPQ 2d 1959 (1988). Unlike College Board, which only helps solve the relatively small problem of locating non-college scholarships and the like for individuals; and Baker, which involves the also relatively small problem of improving the effectiveness of third-party enabling organizations, the present invention helps solve the nationally endemic and *far different* problem of matching individuals—and optionally other types of entities as well—with up to a virtually unlimited number and variety of diverse class/category benefits being offered by a multitude of benefit providers. Because the present invention does therefore solve a different (and far larger and more important) problem than College Board, Baker, or any combination thereof, it is nonobvious.

### Lack of Implementation Proves Nonobviousness

47. If the present invention were in fact obvious, because of its many advantages, those skilled in the art surely would have implemented it long before the present invention's 4/12/2000 PPA priority date. According to the two references, though the College Board method/system has existed in some form since the mid to late 1990's and Baker since June of 1996, it wasn't until the June, 2001 launch of the Benefits Check Up infringing service by the NCOA that applicant's method/system was brought to the marketplace. That's over at least three years of time; which, given the explosive growth of Internet-

based and other business method/systems during this time—*including many 100's (1,000's?) of business-method patent filings plus non-patented operating and proposed systems/methods*—clearly and unequivocally demonstrates and proves that the present invention was neither anticipated by nor made obvious by College Board, Baker, or any combination of the two.

### **The Dependent Claims are A Fortiori Patentable Over College Board and Baker**

48. As demonstrated above, applicant submits that all of his independent claims define novel and unobvious subject matter over the references. All of the dependent claims incorporate all of the limitations of the independent claims and add additional limitations and subject matter and thus are a fortiori patentable. In addition; and especially so in view of the College Board and Baker references being misunderstood, as stated; the following dependent claims are also independently patentable for the following reasons:

49. Dependent claims 16 & 101 (Re OA #11) are independently patentable because they further recite various manners of displaying the available benefits; which is entirely foreign to College Board, Baker, or any combination thereof (“the references”).

50. Dependent claims 17 & 102 (OA #12) are independently patentable because they further recite that entity may self-select the manner of benefits listing display. This is entirely foreign to the references.

51. Dependent claims 18-19 & 103-104 (OA #13) are independently patentable because the storage of part or all of the search results within the system is entirely foreign to the references.

52. Dependent claims 20-21 & 105-106 (OA #14) are independently patentable because the storage of part of all of the search results outside the system is entirely foreign to the references.

53. Dependent claims 22-24 & 107-109 (OA #15) are independently patentable because Baker (C10 L59-67, C11 L1-15) does not teach what OA #15 believes that it does. Specifically, L59-60 discloses, “*... process is performed on a periodic basis to inform consumers ...*” and (L63) “*... daily, weekly, or monthly.*” Showing that this “updating” aspect of Baker is therefore *time-interval-based*. The present invention discloses, on the other hand; automated, changed(ing)-status, *event-based* updating, as seen in this portion of the present invention’s specification:

“In a preferred embodiment, the system includes means to notify system users, via suitably enabled input/output devices 420, of any modification or elimination of existing benefits; or the availability of any new benefits; or the pending modification or elimination of existing benefits; or pending availability of new benefits. In this way users 430 will be constantly kept up to date on the benefit(s) or benefit class(es) most important to them.”

And this from its *Example*:

“Optionally, Dawn may request real time updates of the benefit information via such means as e-mail, FAX, pager, hard-line or web-enabled phone, PDA (Personal Digital Assistants such as the Palm®), etc. Then, the benefit information applicable to her will be automatically updated as the information gathered from the benefit providers is updated.” [Emphasis supplied.]

The distinction is an important one. With Baker (unless you run updates constantly, 24 hours a day, 7 days a week); and especially so since so very many benefits are time-sensitive; who knows what’s available to who for how long and under what conditions, concerning one’s benefits at any given time? With this valuable feature enabled in the present invention, you always know (and *without having to run updates*). This system superiority is clearly entirely foreign to Baker and College Board, or any combination thereof.

C10 L64-67 through C11 L1-7 merely discloses that a consumer may interact either directly or indirectly with the system; while C11 L8-15 merely discloses that the system’s benefit information and *time-interval based* updates may be provided or made available to a consumer via any suitable format/delivery means, e.g. postal mail, e-mail, computer bulletin board, etc.

54. Dependent claims 26 & 111 (OA #17) are independently patentable because displaying a message which does not specify at least one benefit provider is entirely

foreign to the references. Not specifying one or more benefit providers means withholding their identification from the entity which would otherwise normally be disclosed to the entity in the benefit display. Such anonymity at this initial disclosure stage (will) provide(s) an important system advantage to at least some of the benefit providers desiring to withhold their identity until a later stage of the benefit delivery process. College Board and Baker teach nothing about providing such benefit-provider privacy.

55. Dependent claims 27 & 112 (OA #18) are independently patentable because displaying a message which does not specify at least one benefit is entirely foreign to the references. In a similar manner as #54 above; withholding one or more benefits until a later state of the process will prove to be of great value to some of the benefit providers.

56. Dependent claims 30 & 115 (OA #21-26) are independently patentable because, while web-commerce (internet payment systems) were well known by the time invention was made, never before have the income-generation methods disclosed in new claims 30 and 115 ever existed. Now—for the first time ever—a benefit-matching system doesn't have to be advertisement-based or fee-based (or rely on tax dollars like the GovBenefits service does, or on contributions, as the Benefits Check Up service does [recently adding other income-generating systems to their service]). Instead, *the benefits themselves* can supply the revenue needs of the system; freeing the system/company from investing what often proves to be large—sometimes crippling—expenditures in time, effort, and money to build an advertising-supported system. Just as difficult is trying to get people and other entities to pay for the use of such a system before they see if the benefit information/benefits they receive even make it worth the cost. As has been amply and repeatedly reported in the media since the dawn of web-based payment systems precious few web-based companies have been able to make the subscription model work. Most companies trying to use subscriptions quickly lose up to millions of dollars, find themselves drowning in debt, and go out of business.  
Basically, with this teaching, the invention can be set up as a “pay-only-for-results” system/method. If a person/entity actually qualifies for and is able to obtain one or more

benefits, they share some portion of what they receive with the system operator; if not, the entity has incurred no costs of any type for using the system. Most people love paying only for results when such an option is made available to them. Such new, valuable, and unexpected results are clearly superior to what has existed before.

Additionally, applicant submits that the specific recitations of various payment/income options for the invention within the specification does in fact provide the necessary and required support for new claims 30 & 115: "*FIG. 3 is a flow chart . . . Further, central controller 200 charges user's credit or debit card and updates billing information in the user information database 200 to reflect the "purchase" (transmission) of requested benefit information. It is to be understood that numerous other alternative charging/billing and income-generation methods may be used without detracting from the scope of the present invention . . . per benefit received, a percentage of benefit(s) utilized . . . per benefit viewed, per benefit utilized basis, . . .*" from page 13/*Detailed Description of the Invention*.

While it's true that the present invention would work regardless of how the entity paid for system access and use; as *dependent* claims, an exciting new and improved set of payment/income methods could be used to produce valuable new and unexpected results (including no subscription fees for entity use of system, lower system operational costs, and fewer to no advertising difficulties). The entities, the benefit providers, and even the system (operator) itself would all benefit.

As can now be seen, the unique and non-obvious payment/income methods of new/rewritten claims 30 and 115 are functionally involved in the steps recited; having both functional manifestation and novel relation to the invention's structure and operation and making them patentable over College Board and Baker; and therefore allowable under Section 103. Therefore, *In re Gulack* and *In re Lowry* do not apply to new claims 30 and 115. This "pay-only-for-(benefit)results" disclosure is entirely and completely foreign to College Board, Baker, or any combination thereof.

57. Dependent claims 46 & 131 (OA #27) are independently patentable because the receiving of value directly or via third-party intermediaries from one or more of the benefit providers themselves is completely foreign to the references.
58. Dependent claim 48 (OA #29) is independently patentable because the updating, modifying, removing, and adding (new) entity data is—because College Board and Baker teach only *individuals*, as stated—entirely foreign to the references.
59. Dependent claims 49 & 133 (OA #30) are independently patentable because, in the very least, providing a map and directions to the benefit providers is completely foreign to the references.
60. Dependent claims 50 & 134 (OA #31) are independently patentable because maintaining the anonymity of one or more of the benefit providers which would otherwise be revealed is entirely foreign to the references (and as per #54 above).
61. Dependent claims 51, 52, 135, 136 (OA #32) are independently patentable. While it's true that links predate the invention; using them to access any required benefit provider application forms can at times be surprisingly problematic. Links are often known to "break;" directing visitors to either no site, the wrong location in often 100+page benefit-provider web-sites, or to wrong sites entirely. Also, while most of the 2<sup>nd</sup> OA directs itself to College Board and Baker; as is made clear in the present invention's specification, many of the invention's potential benefit providers may choose to keep their identity hidden from various benefit-seeking entities. Unlike with links to benefit provider forms found at the providers' own websites, application forms made available instead as part of the benefit search results would maintain this confidentiality.

Next, note that College Board's EXPAN system, unlike their Scholarship Search system, is a combination online/offline system which is not web based. To use EXPAN requires a personal meeting with a counselor or other school official to complete the requisite questionnaire; or the taking home of a disk to do the same thing. The information is then

either mailed in or transmitted--apparently over phone lines to a BBS--via the use of proprietary software. Trying to use such a system to obtain timely help in completing sometimes very complicated benefit application forms would be unwieldy in the least; near impossible in the worst.

Therefore, the result of the present invention's superior ability to more quickly and easily--and, when needed/desired--*privately and confidentially*--provide the actual application forms and assistance in completing them produces new, valuable, exciting, and unexpected results.

Thus applicant submits that this important and valuable invention option is much more than merely a combination of College Board and/or EXPAN with links; and that--under 35 USC 103--the distinguishing matter of claims 51, 52, 135, and 136 are also entirely foreign to College Board, Baker, or any combination thereof.

62. Dependent claims 54 & 138 (OA #35) are independently patentable because they recite a deeper, more comprehensive (and much more valuable) involvement between the entities and the benefit providers once the benefits applicable to the entities have been identified by the system. College Board and Baker teach only the (limited, as stated) *identification* of benefits (for individuals). Yet, once the benefits have been identified, what next? Should the entity call, or visit, or mail the providers? Who should they ask for? What department? Which office/location? How does one get the forms? Can someone help complete them? How does one receive the benefits? By mail? Fax? Personal visit? Claims 54 and 138 make all these logistical difficulties simple. The references teach none of this novel, unobvious ability. Only the present invention.

63. Dependent claims 55 & 139 (OA #36) are a fortiori independently patentable because claims 54 and 138 are, as stated, novel and unobvious.

64. Dependent claims 58 & 142 (OA #37) are independently patentable because the sharing of the benefits information with another via said system and an internet is entirely foreign to the references.

65. Dependent claims 59 & 143 (OA #38) are independently patentable because the sharing of the benefits with another via said system and an internet is entirely foreign to the references.

66. Dependent claims 60 & 144 (OA # 39) are independently patentable because the availability of benefits which have no acquisition, utilization, or eligibility requirements is completely foreign to the references. Only the present invention—with these two claims—is able to make available valuable benefits *without* having to qualify for them. This is an important teaching College Board and Baker say nothing about; all of their benefits requiring various qualification parameters.

67. Dependent claims 61 & 145 (OA #40) are independently patentable because obtaining, displaying, accepting, providing, and utilizing at least one of the *no-qualifying-needed* benefits is completely foreign to the references; as with claims 60 and 144.

68. Dependent claims 62 & 146 (OA #41) are independently patentable because they teach an even more encompassing disclosure of benefits to an entity. By displaying “may, may not, does and does not qualify for benefits,” an entity can discover additional benefits which entity could—by, for example, adjusting its preferences—qualify to obtain which they otherwise wouldn’t even know about. It’s a way to see what benefits a given entity is or may be *close to being qualified* to receive. This obviously valuable and important benefit-identification and acquisition option is completely foreign to the references.

69. Dependent claims 64 & 148 (OA #42) are independently patentable because the availability of benefits without regards to an entity’s data set; and whether or not entity qualifies for or is eligible for any benefits is completely foreign to the references. This ability allows an entity to discover which benefits are available via the system; which would, for example, help entity to decide whether or not to use the system (especially valuable where the entity must pay in order to use the system). Only the present

invention—with these two claims—allows a benefit-seeking entity to have a “sneak peek” at “all” the benefits available via the system. This is an important teaching College Board and Baker say nothing about; the benefits displayed being only those for which an individual is (or appears to be) qualified to receive.

70. Dependent claims 65 & 149 (OA #43) are independently patentable because they recite wherein one or more of said benefit providers may at benefit providers’ option submit said benefit information directly into said system. The ability of benefit providers and the system (operator) to greatly reduce or eliminate human involvement and interaction in, for example; the identification of, gathering of, inputting in (to the system), and managing and updating of the benefits information and/or the benefits is of tremendous cost-saving and operational efficiency value. There being not even a single sentence concerning this novel and unobvious teaching in either reference, such valuable, *produces-new-and-unexpected-results* benefit-provider direct submission is clearly and entirely foreign to College Board, Baker, or any combination thereof.

71. Dependent claims 66 & 150 (OA #44) are independently patentable because the use of (a) third-party intermediaries is completely foreign to the references.

72. Dependent claims 67 & 151 (OA #45) are independently patentable because an entity’s selection of the frequency of system updates concerning at least one benefit and/or one benefit class is entirely foreign to the reference.

73. Dependent claims 73 & 157 (OA #50) are independently patentable because delivering one or more of the benefits themselves via an internet is (by making obtaining applicable benefits more quickly and easily) an obviously valuable feature which is completely foreign to the references. College Board and Baker teach nothing about this.

74. Dependent claims 74 & 158 (OA #51) are independently patentable because utilizing one or more of the benefits themselves via an internet is (by making the using of applicable benefits quicker and easier) an obviously valuable feature which is completely foreign to the references. College Board and Baker teach nothing about this.

75. Dependent claims 166 & 171 (OA #71) are independently patentable because receiving (creating) benefit information that does not specify one or more benefit providers is entirely foreign to the references. Not specifying one or more benefit providers means withholding their identification from the entity which would otherwise normally be disclosed to the entity in the benefit display(s). Such anonymity at this initial disclosure stage (will) provide(s) an important system advantage to at least some of the benefit providers desiring to withhold their identity until a later stage of the benefit delivery process. College Board and Baker teach nothing about providing such benefit-provider privacy.

76. Dependent claims 167 & 173 (OA #72) are independently patentable for the same reasons as #75 above.

77. Dependent claim 174 (OA #74) is independently patentable because providing a benefit listing without one or more benefit providers being listed is entirely foreign to the references. Not providing one or more benefit providers means withholding their identification from the entity which would otherwise normally be disclosed to the entity in the benefit display(s). Such anonymity at this initial disclosure stage (will) provide(s) an important system advantage to at least some of the benefit providers desiring to withhold their identity until a later stage of the benefit delivery process. College Board and Baker teach nothing about providing such benefit-provider privacy.

Applicant accordingly submits that the dependent claims are a fortiori patentable and should also be allowed.

### Conclusion

For all of the above reasons, applicant submits that the claims are now in proper form; that the proposed combination is not justified; but even if made the claims would still all define patentable and unobvious subject matter over the prior art. Therefore applicant submits that this application is now in condition for allowance, which action applicant respectfully solicits.

**Conditional Request for Constructive Assistance**

Applicant has (previously) rewritten the abstract and amended/rewritten the claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If for any reason this application is not believed to be in full condition for allowance, the pro se applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to MPEP 2173.02 and 707.07 (j) (and/or other) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings. The Examiner is authorized to make any needed minor corrections or changes.

Very respectfully,



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**Attachment: (Claims) Appendix to Amendment B**

**Certificate of Faxing:** I hereby certify that I will Fax this paper to GAU 3629 of the U.S. Patent and Trademark Office at 703-305-3597 on the date below:

Date: March 24, 2004



Steve Morsa, Applicant